



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)  
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Docket Number (Optional)

FS-F03210-01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/687,116

Filed

October 17, 2003

First Named Inventor

Fumito Nariyuki

Art Unit

1752

Examiner

Thorl Chea

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

52,053

Registration number \_\_\_\_\_

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Sheldon J. Moss

Typed or printed name

703-838-8013

Telephone number

November 24, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.: 10/687,116 Confirmation No. 7360  
Applicant: Fumito NARIYUKI  
Filed: October 17, 2003  
Title: PHOTOTHERMOGRAPHIC MATERIAL AND IMAGE FORMING METHOD  
FOR THE PHOTOTHERMOGRAPHIC MATERIAL  
Art Unit: 1752  
Examiner: Thorl Chea  
Docket No.: FS-F03210-01  
Cust. No.: 37398

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

**1. Introduction**

Applicant submits the following arguments in support of the Pre-appeal Brief Request for Review. Applicant submits that there is at least one legal deficiency and at least one factual deficiency in the rejections. The legal deficiency lies in the Examiner's failure to present a prima facie case of obviousness by failing to demonstrate that there is a suggestion or motivation to modify the reference(s) to arrive at Applicant's claimed invention. The factual deficiency is based on the Examiner's failure to cite any reference teaching one of the limitations of Applicant's claimed invention.

Because the legal and factual deficiencies involve claim 18, that claim is reproduced below:

18. An image forming method with a photothermographic sheet material, comprising imagewise exposing and thermally developing the photothermographic sheet material;

wherein the photothermographic material comprising at least a photosensitive silver halide having an average silver iodide content of 40% by mole or more, a non-photosensitive organic silver salt, a reducing agent and a binder, and a compound expressed by the following formula (H):

Formula (H):  $Q - (Y)_N - C(Z_1)(Z_2)X$

wherein Q represents an alkyl group, an aryl group or a hetero ring group; Y represents a divalent linkage group; N represents 0 or 1;  $Z_1$  and  $Z_2$  each independently represent a halogen atom; and X represents a hydrogen atom or an electron-withdrawing group;

and the thermal developing being started within 60 sec after imagewise exposure of the photothermographic sheet material and

wherein the imagewise exposing and thermal developing comprises imagewise exposing a part of the sheet and simultaneously developing a part of the sheet that has already been imagewise exposed.

## **2. Legal Deficiency**

Claim 18 stands rejected under 35 USC 103(a) as set forth in the final Office action dated June 28, 2005 and the Advisory Action dated November 15, 2005.

Applicant asserts that the Examiner has failed to present a prima facie case of obviousness regarding the final "wherein" clause of claim 18:

...wherein the imagewise exposing and thermal developing comprises imagewise exposing a part of the sheet and simultaneously developing a part of the sheet that has already been imagewise exposed.

More specifically, the Examiner has failed to cite any reference that teaches or suggests the above-noted claim limitation. Based on page 2 of the Advisory Action dated November 15, 2005, the Examiner's basis for the rejection seems to be that:

"The interval of time between the imagewise exposure and heat developing would not have been found critical by the worker of ordinary skill in the art in the absence of showing otherwise. The worker of ordinary skill in the art would expect that the photographic sheet material can be partially exposed and simultaneously heat developed or wholly imagewise exposed and then heat developed with an expectation of forming an image."

The first problem with that statement by the Examiner is that it is based on speculation alone and not on the teaching or suggestion of any prior art reference. The second problem with that statement is that it directly contradicts the Examiner's own remarks made at the end of Paragraph 4 of the Office action dated June 28, 2005, which read:

"The worker of ordinary skill in the art would have applied heat development right after imagewise exposure due to the instability of the latent image formed in the material after imagewise exposure."

The two passages quoted above demonstrate that the Examiner has provided two separate and irreconcilable explanations for why the worker of ordinary skill in the art would find Applicant's invention obvious. The first passage says that the time interval between exposing and developing is not critical, but the second passage states just the opposite by saying that exposure followed by quick development would be necessary due to latent image instability. In either case, both of those bases for obviousness are mere supposition on the part of the Examiner and not supported by any prior art teaching.

### **3. Factual Deficiency**

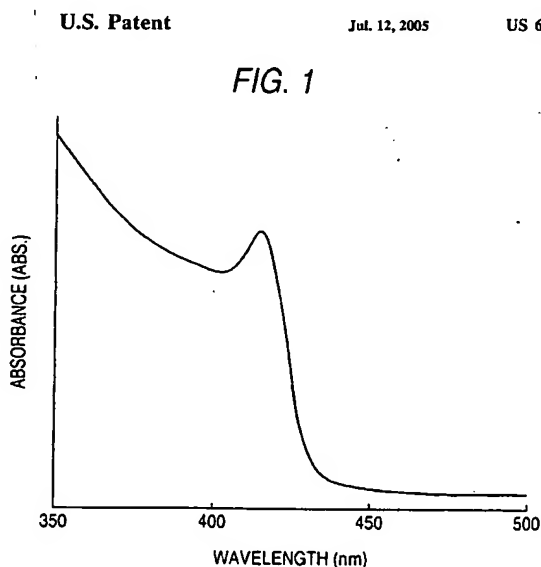
While the cited references are directed toward photographic materials, their focus is on the photographic materials themselves and not on exposure and development processes. Regarding the relationship between exposure and development, the cited references disclose only that development occurs after exposure. More specifically, none of the references discusses the period of time between exposure and development, let alone simultaneous exposure and development.

Accordingly, there is a factual deficiency in that the Examiner has failed to cite any reference that teaches or suggests simultaneous exposure and development.

#### **4. Drawing Objection**

Figure 1 stands objected to under 37 CFR 1.83(a) for failing “to show the scale in the Absorption axe in Fig. 1 as described in the specification.” (see Office action dated June 28, 2005). This objection is erroneous. Figure 1 represents an absorption spectra that would be immediately identifiable as such by a person of ordinary skill in the art. This is because the x-axis is labeled as “Wavelength (nm)” and the y-axis is label as “Absorption.” The worker of ordinary skill would also understand that, in an absorption spectra, absorption is a relative measure and therefore a scale on the y-axis is not necessary to understanding the spectra. Moreover, on April 8, 2005, Applicant submitted an Amendment and Response that included photocopied pages from “Image Process and Materials, Neblette’s Eight Edition.” Fig. 8-1 of Neblette’s shows an absorption spectra that does not contain numerical scale units.

Applicant also submits that this Examiner in the past has allowed patent applications that contain figures representing absorption spectra that were labeled the same way as Figure 1 in the present application. For example, the Examiner issued US Patent No. 6,916,599 to Nariyuki (same Applicant as the present application) and Figure 1 in that patent is an absorption spectra that appears as:



**5. Conclusion**

It is respectfully submitted that the Examiner's rejection is legally deficient for failing to make a prima facie case of obviousness. It is further submitted that the references, either alone or in combination, fail to teach the simultaneously exposing and developing limitation of independent claim 18. Finally, the objection to Figure 1 is erroneous.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sheldon J. Moss", written over a horizontal line.

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November 25, 2005